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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/556,225	11/09/2005	Axel Kohnke	915-006,098	4862
4955 7590 10/26/2010 WARE FRESSOLA VAN DER SLUYS & ADOLPHSON, LLP BRADFORD GREEN, BUILDING 5 755 MAIN STREET, P O BOX 224 MONROE, CT 06468				
EXAMINER LAI, MICHAEL C				
ART UNIT 2457		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/556,225

**Applicant(s)**

KOHNEKE, AXEL

**Examiner**

MICHAEL C. LAI

**Art Unit**

2457

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 August 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6, 8-11, 13, 15, 16, 18 and 19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-11, 13, 15, 16, 18 and 19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This office action is responsive to communication filed on 8/11/2010.

#### ***Response to Amendment***

2. The examiner has acknowledged no amended claims. Claims 1-6, 8-11, 13, 15, 16, 18 and 19 are pending.

#### ***Response to Arguments***

3. Applicant's arguments, see page 2, filed 8/11/2010, with respect to "There is no mention at all of any telephone number (in Sears)...There is nothing in the Sears et al reference that would add such a feature to the disclosure of De Beer and the obviousness rejection to claim 1 is therefore inapplicable", is not persuasive.

It is the combination of De Beer and Sears that meets the limitation of "receiving a response from said network serving entity, said response comprising network information identifying one or more network operators providing services to said one or more telephone numbers", not Sears alone. As indicated in the last office action, De Beer meets the limitation of "receiving a response from said network serving entity, said response containing information associated with said one or more telephone numbers". Sears discloses sending data to the mobile device relating to **identification of the available service providers** and the associated mobile service subscription choices [0039-0041], wherein the choices of available service providers [0038-0041] and the associated subscription choices are sent to the mobile device over a wireless communication path [0012-0013], the choices of service providers [0012-0013] and subscription choices are

for selection by a user of the mobile device [0039-0041]. It is well known in the art that the identification of a mobile device could be a telephone number. Thus a person with ordinary skill in the art would have no problem to combine the teachings of De Beer and Sears and reach the claimed limitation.

4. Applicant's arguments, see pages 2-3, filed 8/11/2010, with respect to the rationale for justifying the combination of De Beer and Sears, is not persuasive.

In response to applicant's arguments, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art, as discussed above Item 3. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

5. In view of the foregoing, it is evident that the invention according to claims 1-4, 6, 8-11, 13, 15-16, and 18-19 is obvious under 35 U.S.C. 103(a) as being unpatentable over De Beer in view of Sears.

Thus, in view of such, the rejection is sustained as follows:

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-4, 6, 8-11, 13, 15-16, and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over De Beer (2003/0165227, hereinafter De Beer), and in view of Sears et al. (US 2002/0069263 A1, hereinafter Sears).

Regarding claim 1, De Beer discloses a method comprising:

coding a request comprising one or more telephone numbers [para. 52, step 43, generates a request message in the SMS format];

transmitting said request to a network serving entity for performing said network information retrieval [para. 53, step 45];

receiving a response from said network serving entity, said response comprising network information associated with said one or more telephone numbers [para. 0054, updating information and service provider; para. 0055, step 47; para. 0056, "the routing data may comprise a prefix code to be added to the input telephone number stored in the buffer memory 90 by the processor 30"];

decoding said response to extract said network information [para. 0055, lines 1-6]; and

storing said network information in conjunction with said one or more telephone numbers [para. 0055, step 48].

De Beer discloses receiving a response from said network serving entity, said response containing information associated with said **telephone numbers** except that there are no identifications of network operators providing services. However, Sears teaches sending data to the mobile device relating to **identification of the available service providers** and the associated mobile

service subscription choices [0039-0041], wherein the choices of available service providers [0038-0041] and the associated subscription choices are sent to the mobile device over a wireless communication path [0012-0013], the choices of service providers [0012-0013] and subscription choices are for selection by a user of the mobile device [0039-0041]. Thus the combination of De Beer and Sears meets the limitation of "receiving a response from said network serving entity, said response comprising network information identifying one or more network operators providing services to said one or more telephone numbers". It would have been obvious to a person with ordinary skill in the art at the time the invention was made to incorporate Sears's teaching into De Beer's method in order to provide the user with more options for selecting and/or downloading the different service plans, or advertisements such as sales from different providers for saving cost.

Regarding claim 2, De Beer and Sears further discloses a method according to claim 1, wherein the response is structured into at least one information record, said information record includes one telephone number of said one or more telephone numbers and a network operator providing services to said one telephone number [De Beer, FIG. 6 and para. 0054; Sears, para. 0012-0013, 0039-0041]. See motivation in claim 1.

Regarding claim 3, De Beer further discloses a method according to claim 1, further comprising:

selecting said one or more telephone numbers from a plurality of telephone numbers stored in a telephone directory of a communication terminal [para. 0123, phonebook].

Regarding claim 4, De Beer further discloses a method according to claim 3, wherein said selecting is performed manually by a user of said communication terminal [para. 0052].

Regarding claim 6, De Beer further discloses a method according to claim 2, wherein storing said network information comprises:

identifying at least one telephone directory entry in a telephone directory of a communication terminal on the basis of said one telephone number that is included in said information record [para. 0057];

storing said network information by including said network information into said at least one identified telephone directory entry [para. 0055, step 48].

Regarding claim 8, De Beer further discloses a method according to claim 1, wherein said network information further comprises charging information [para. 0004, updating information and charging rate].

Regarding claim 9, De Beer discloses a method comprising:

receiving a request from a communication terminal, wherein said request comprises one or more telephone numbers [para. 0054, note that "the control center responds by sending a response message to the mobile" implies that it has received a request from the mobile.];

decoding said request to extract said one or more telephone numbers [para. 0053, note that the mobile sending the request message in SMS format to the control center implies the message must be decoded by the control center];

coding a response which comprises said retrieved network information [para. 0055, note that decoding the response message from the control center implies coding the response message by the control center]; and

transmitting said response to said communication terminal [para. 0054, step 46].

De Beer discloses the claimed invention except for retrieving network information identifying one or more network operators providing services to said one or more telephone numbers. However, Sears teaches sending data to the mobile device relating to identification of the available service providers and the associated mobile service subscription choices [0039-0041], wherein the choices of available service providers [0038-0041] and the associated subscription choices are sent to the mobile device over a wireless communication path [0012-0013], the choices of service providers [0012-0013] and subscription choices are for selection by a user of the mobile device [0039-0041]. Thus the combination of De Beer and Sears meets the limitation of "retrieving network information identifying one or more network operators providing services to said one or more telephone numbers". It would have been obvious to a person with ordinary skill in the art at the time the invention was made to incorporate Sears's teaching into De Beer's method in order to provide the user with more options for selecting

and/or downloading the different service plans, or advertisements such as sales from different providers for saving cost.

Regarding claim 10, De Beer and Sears further discloses a method according to claim 9, wherein retrieving network information comprises accessing a data storage which stores network information identifying one or more network operators providing services to a plurality of telephone numbers [De Beer, FIG. 2 and para. 0038, the control center 7 and the database 10; Sears, para. 0012-0013, 0039-0041]. See motivation in claim 9.

Regarding claim 11, De Beer and Sears further discloses a method according to claim 9, wherein said response is structured into at least one information record including one telephone number of said one or more telephone numbers and a network operator providing services to said one telephone number [De Beer, para. 0055, note that decoding the response message from the control center implies coding the response message by the control center; Sears, para. 0012-0013, 0039-0041]. See motivation in claim 9.

Regarding claim 13, De Beer further discloses a method according to claim 9, wherein said network information further comprises charging information [para. 0004, updating information and charging rate].

Claims 15 and 18 are of the same scope as claim 1. They are rejected for the same reason as for claim 1.

Claims 16 and 19 are of the same scope as claim 9. They are rejected for the same reason as for claim 9.

8. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over De Beer and Sears as applied to claim 3, and further in view of Tomiyori (US 5,305,372, hereinafter Tomiyori).

Regarding claim 5, De Beer and Sears disclose a method according to claim 3, but silent about wherein said selecting is performed automatically in accordance with a pre-defined selection definition. However, Tomiyori teaches a speed dialing memory storing a plurality of destination address numbers corresponding to user-defined speed dialing codes [col. 1, lines 44-50 and col. 2, lines 61-68]. It would have been obvious to a person with ordinary skill in the art at the time the invention was made to incorporate Tomiyori's teaching into De Beer's and Sears's method for the purpose of speed dialing by a pre-defined selection definition, thereby providing a more user friendly service.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory

action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**Examiner's Note:** Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL C. LAI whose telephone number is (571)270-3236. The examiner can normally be reached on M-F 8:30 - 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax

phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael C. Lai  
19OCT2010

/YVES DALENCOURT/  
Primary Examiner, Art Unit 2457